

REMARKS:

Claims 1-32 are currently pending in the application. Claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2002/0111870 to Chinnapapan et al. ("Chinnapapan"). Claims 3, 14, 15, 25, and 26 stand rejected under 35 U.S.C. § 103(a) over Chinnapapan in view of U.S. Patent No. 5,758,328 to Giovannoli ("Giovannoli"). Claims 9, 20, and 31 stand rejected under 35 U.S.C. § 103(a) over Chinnapapan in view of U.S. Patent Application Publication No. 2005/0154652 to Bezos et al. ("Bezos").

By this Amendment, the Applicants have amended independent claim 1 and dependent claims 2, 3, 7, and 8 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In addition, the Applicants have amended dependent claims 4, 5, 9, 11-20, and 22-31 to correct certain typographical errors. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1, 2, 3, 7, and 8. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Specifically, the Examiner asserts "a seller selection interface operable to receive one or more seller requirements from a user and to generate one or more custom global content directories based on the seller requirements" implies that the generation of one or more custom global content directories is executed by the seller selection interface, which

was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. (11 August 2005 Office Action, Page 2). The Applicants disagree.

Nonetheless, the Applicants have amended independent claim 1 and dependent claims 2, 3, 7, and 8 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In addition, the Applicants have amended dependent claims 4, 5, and 9 to correct certain typographical errors and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent Application of substantially the same scope of originally filed claims 1, 2, 3, 7, and 8.

The Applicants submit that amended independent claim 1 is considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further submit that amended independent claim 1 is in condition for allowance.

With respect to dependent claims 2-9, claims 2-9 depend from amended independent claim 1. As mentioned above, amended independent claim 1 is considered to be in full compliance with the requirements of 35 U.S.C. § 112. Thus, dependent claims 2-9 are considered to be in condition for allowance for at least the reason of depending from an allowable claim. Thus, the Applicants respectfully request that the rejection of claims 1-9 under 35 U.S.C. § 112 be reconsidered and that claims 1-9 be allowed.

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 stand rejected under 35 U.S.C. § 102(e) over Chinnapapan.

Although the Applicants believe claims 1, 2, 4, 7, 8, 11-13, 16-19, 22-24, and 27-30 are directed to patentable subject matter without amendment, the Applicants have amended independent claim 1 and dependent claims 2, 3, 7, and 8 to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 4, 11-13, 16-19, 22-24, and 27-30 have been amended to correct certain typographical errors. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicants respectfully submit that the subject Application and the Chinnapapan U.S. Patent Application Publication were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, i2 Technologies US, Inc. In accordance with 35 U.S.C. § 103(c) and MPEP 706.02(I)(1), Chinnapapan is disqualified as prior art under 35 U.S.C. § 102(e) in the subject Application. Thus, the Applicants respectfully submit that claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 are in condition for allowance.

As mentioned above, the rejections under 35 U.S.C. §102(e) are moot in view of Chinnapapan being rejected as prior art. Thus, for at least the reasons set forth herein, the Applicants submit that claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 are not anticipated by Chinnapapan. The Applicants further submit that claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 under 35 U.S.C. § 102(e) be reconsidered and that claims 1, 2, 4-8, 10-13, 16-19, 21-24, 27-30, and 32 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.
7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that

claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession

of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 3, 14, 15, 25, and 26 stand rejected under 35 U.S.C. § 103(a) over Chinnapapan in view of Giovannoli. Claims 9, 20, and 31 stand rejected under 35 U.S.C. § 103(a) over Chinnapapan in view of Bezos.

Although the Applicants believe claims 3, 9, 14, 15, 20, 25, 26, and 31 are directed to patentable subject matter without amendment, the Applicants have amended dependent claim 3 to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 9, 14, 15, 20, 25, 26, and 31 have been amended

to correct certain typographical errors. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that the subject Application and the Chinnapapan U.S. Patent Application Publication were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, i2 Technologies US, Inc. Thus, in accordance with 35 U.S.C. § 103(c) and MPEP 706.02(I)(1), Chinnapapan is disqualified as prior art under 35 U.S.C. § 103(a) in the subject Application.

The Applicants respectfully submit that Chinnapapan, Giovannoli, and Bezos, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 9, 14, 15, 20, 25, 26, and 31. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 3, 9, 14, 15, 20, 25, 26, and 31 under 35 U.S.C. § 103(a) over the proposed combination of Chinnapapan, Giovannoli, or Bezos, either individually or in combination. Furthermore, as mentioned above, the Applicants respectfully submit that the rejections under 35 U.S.C. §103(a) are moot in view of Chinnapapan being rejected as prior art.

For example, with respect to amended dependent claim 3, this claim recites:

The [electronic commerce] system of Claim 2, [applying dynamic database redirection and] further operable to:

determine a geographic location for the user and one or more languages that correspond to the geographic location of the user; and generate custom global content directories where the pointers identify seller databases in the languages corresponding to the geographic location of the user. (Emphasis Added).

Amended dependent claims 14, 15, 25, and 26 recite similar limitations. Chinnapapan and Giovannoli, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 3, 14, 15, 25, and 26.

The Applicants respectfully submit that the Office Action acknowledges, and Applicants agree, that Chinnapapan fails to disclose the emphasized limitations noted above in amended dependent claim 3. Specifically the Examiner acknowledges that Chinnapapan fails to disclose that said interface is further configured to determining a geographic location for the use and one or more languages that correspond to the geographic location of the user. (11 August 2005 Office Action, Pages 9-10). However, the Examiner asserts that the cited portions of Giovannoli teach a method and system for conducting communications between buyers and sellers over a network, including an interface configured to determine a geographic location for the user and one or more languages that correspond to the geographic location of the user. (11 August 2005 Office Action, Pages 9-10). The Applicants disagree. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Giovannoli.

The Applicants respectfully submit that Giovannoli has nothing to do with the amended dependent claim 3 limitations regarding an electronic commerce system applying dynamic database redirection and in particular Giovannoli has nothing to do with amended dependent claim 3 limitations regarding: (1) determining a geographic location and a language corresponding to the geographic location of the user and (2) generating custom global content directories, where the pointers identify seller databases in the languages corresponding to the geographic location of the user. Rather, Giovannoli describes an approach for processing requests for quotation through a central processing unit. (Abstract). The Applicants direct the Examiner's attention to the cited portions of Giovannoli, relied upon by the Examiner:

The RFQ is then processed to select vendors who are capable of quoting on the RFQ and who meet any other conditions set by the requesting buyer (e.g. language, currency, or vendor location). (Column 5, Line 9-12).

For example, a buyer who specifies vendors of volt meters in New York State will reach more vendors than if New York City alone were specified. Such class specifications are information filters through which only the desired vendors can pass. (Column 5, Line 9-12).

Although, Giovannoli discloses a potential condition of language set by the requesting buyer and a population comparison between New York State and New York City, Giovannoli fails to disclose that the condition of language is associated in anyway with determining a geographic location or that the population comparison is in anyway associated with generating a custom global content directory having pointers identifying seller databases. Thus Giovannoli cannot provide for an electronic commerce system applying dynamic database redirection generating custom global content directories, where the pointers identify seller databases in the languages corresponding to the geographic location of the user, since Giovannoli does not even provide for a condition of language associated with the user geographical location.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Chinnapapan and Giovannoli, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Chinnapapan and Giovannoli as proposed. The Office Action merely states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chinnapapan to include that said interface is further configured to determining a geographic location for the user and one or more languages that correspond to the geographic location of the user, as taught by Giovannoli. (11 August 2005 Office Action, Page 10). The Applicants respectfully disagree.

The Applicants further submit that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in Chinnapapan or Giovannoli, either individually or in combination. The Examiner asserts that a person having ordinary skill in the art at the time the invention was made, would make such a modification because it would advantageously allow the buyers to choose sellers from locations that would be preferable from delivery and shipping cost points of views. (11 August 2005 Office Action, Page 10). The Applicants respectfully disagree. The Applicants respectfully request the Examiner to point to the portions of Chinnapapan or Giovannoli which contain the teaching, suggestion, or motivation to combine Chinnapapan

or Giovannoli for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a). A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Chinnapapan or Giovannoli, either individually or in combination.

In addition, the Applicants respectfully submit that the rejection of dependent claims 3, 14, 15, 25, and 26 based on the proposed combination of Chinnapapan and Giovannoli are improper because the rejections under 35 U.S.C. §103(a) are moot in view of Chinnapapan being rejected as prior art. Furthermore, even if the combination of Chinnapapan and Giovannoli were proper, the proposed combination of Chinnapapan and Giovannoli fails to remedy the deficiencies of Chinnapapan.

The Applicants respectfully submit that the Office Action acknowledges, and Applicants agree, that Bezos fails to disclose the emphasized limitations noted above in amended dependent claim 9. Specifically the Examiner acknowledges that Bezos fails to disclose that the seller selection interface is further operable to receive an access code from the buyer. (11 August 2005 Office Action, Pages 10-11). However, the Examiner asserts that the cited portion of Bezos teaches an electronic catalog system, wherein a customer uses a password to enter the database. (11 August 2005 Office Action, Pages 10-11). The Applicants disagree. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Bezos and direct the Examiner's attention to amended dependent claim 9, this claim recites:

The [electronic commerce] system of Claim 8, [applying dynamic database redirection] wherein the seller selection interface is further operable to receive an access code from the buyer, the access code

operable to allow the buyer to search the product data associated with the private global content directories. (Emphasis Added).

Amended dependent claims 20 and 31 recite similar limitations. Chinnapapan and Bezos, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 9, 20, and 31.

The Applicants respectfully submit that Bezos has nothing to do with the amended dependent claim 9 limitations regarding an electronic commerce system applying dynamic database redirection and in particular Bezos has nothing to do with amended dependent claim 9 limitations regarding a seller selection interface operable to receive an access code from a buyer to allow the buyer to search the product data associated with the private global content directories. Rather, Bezos describes an electronic catalog system that presents context-sensitive account information to customers during a browsing of an electronic catalog. (Abstract). The Applicants direct the Examiner's attention to the cited portions of Bezos, relied upon by the Examiner:

[0058] a. Customer Database

[0059] The customer database 324 stores information about existing customers of the merchant web site 320. This information may include the name, shipping address, e-mail address, payment information, login identifier, password, and one-click settings of the customer.

[0060] b. Inline Information Database

[0063] The inline information database 325 may also include rules that govern the level of confidence needed before presenting information to the customer. For example, one rule may require that the customer's operating system match the "default" operating system specified in the customer's profile. Another rule may request a login/password pair from the customer.

Although, the examiner seems to be focused on the login and password disclosed in Bezos, Bezos fails to disclose that this login or password provides a buyer with the ability to search the product data associated with the private global content directories. In fact, the login or password cited by the Examiner in Bezos, is actually associated with two

different databases, i.e. a customer database 324 and an inline information database 325 and is not in anyway associated with, or related to, the seller selection interface disclosed in the subject Application. Thus Bezos cannot provide for an electronic commerce system applying dynamic database redirection, including a seller selection interface operable to receive an access code from a buyer to allow the buyer to search the product data associated with the private global content directories, since Bezos does not even provide for an access code to search the product data in the first place.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Chinnapapan and Bezos, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Chinnapapan and Bezos as proposed. The Office Action merely states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chinnapapan to include that the seller selection interface is further operable to receive an access code from the buyer, as disclosed in Bezos. (11 August 2005 Office Action, Page 11). The Applicants respectfully disagree.

The Applicants further submit that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in Chinnapapan or Bezos, either individually or in combination. The Examiner asserts that a person having ordinary skill in the art at the time the invention was made, would make such a modification because it would enhance the security of the system, and allow only authorized buyers to access the system. (11 August 2005 Office Action, Page 11). The Applicants respectfully disagree. The Applicants respectfully request the Examiner to point to the portions of Chinnapapan or Bezos which contain the teaching, suggestion, or motivation to combine Chinnapapan or Bezos for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a). A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each

and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Chinnapapan or Bezos, either individually or in combination.

In addition, the Applicants respectfully submit that the rejection of dependent claims 9, 20, and 31 based on the proposed combination of Chinnapapan and Bezos are improper because the rejections under 35 U.S.C. §103(a) are moot in view of Chinnapapan being rejected as prior art. Furthermore, even if the combination of Chinnapapan and Bezos were proper, the proposed combination of Chinnapapan and Bezos fails to remedy the deficiencies of Chinnapapan.

As mentioned above, amended independent claim 1 and independent claims 10 and 21 are considered patentably distinguishable over Chinnapapan, Giovannoli, and Bezos. With respect to dependent claims 3, 9, 14, 15, 20, 25, 26, and 31: claims 3 and 9 depend from amended independent claim 1; claims 14, 15, and 20 depend from independent claim 10; and claims 25, 26, and 31 depend from independent claim 21. As mentioned above, each of independent claims 1, 10, and 21 are considered patentably distinguishable over the proposed combination of Chinnapapan, Giovannoli, and Bezos. Thus, dependent claims 3, 9, 14, 15, 20, 25, 26, and 31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 3, 9, 14, 15, 20, 25, 26, and 31 are not rendered obvious by the proposed combination of Chinnapapan, Giovannoli, and Bezos. The Applicants further submit that claims 13, 9, 14, 15, 20, 25, 26, and 31 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 3, 9, 14, 15, 20, 25, 26, and 31 under 35 U.S.C. § 103(a) be reconsidered and that claims 3, 9, 14, 15, 20, 25, 26, and 31 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no additional fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

10/6/05
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